

Remarks

Claims 1-16 and 18-41 were pending in the application. Claims 1, 26, 32, 38 and 39 are herein amended. Claim 3 is hereby canceled.

Rejections under 35 U.S.C. §102(e)

The Examiner has rejected claims 1, 4-14, 26, 30-32, 36-41 under 35 U.S.C. §102(e) as being anticipated by Ogawa et al. (US Pub No. 2002/0024992 A1). Claims 1, 26, 32, 38 and 39 have been amended.

To properly establish a prime facie case of anticipation, all of the claimed elements must be found in a single prior art reference. If any of the claimed elements are not found in the reference, then a case of anticipation cannot be properly established.

Claim 1 has been amended to contain the limitations of claim 3 and is believed to be allowable. As such, it will be addressed below with respect to the rejection of claim 3. Claims 38 and 39 contain similar language to the language added to claim 1. The allowability of these claims will be addressed below as well. Claims 4-14 are dependent upon claim 1 and are thus believed to be allowable.

Claims 26 and 32 have been amended to contain the language "each of the one or more finger processors comprising a rotator." Support for this amendment can be found in Figure 4 of the present application as element 440 and in paragraph [1050]. The Ogawa reference does not disclose or suggest that the finger processors each comprise a rotator. In fact, the reference is directed to a searcher and provides little information about finger processors. See, e.g., paragraph [0038]. Claims 26 and 32 are believed to be allowable.

Claims 30-31 and 40-41 are ultimately dependent upon claim 26 and should therefore be allowable. Claims 36 and 37 are dependent upon claim 32 and should therefore be allowable.

The Examiner has rejected claims 16, 18, and 20-24 under 35 U.S.C. §102(e) as being anticipated by Challa et al. (US Patent 6,700,922). On page 8 of the Office Action, the Examiner states “However Challa does not teach terminating the evaluating upon diction of pilot acquisition.” (emphasis in original). This language appears in claim 16. Thus, according to the Examiner’s own admission, Challa does not teach all of the elements of the claim 16. Thus, the anticipation rejection is improper and should be withdrawn. Claim 16 is believed to be allowable as will be discussed below with respect to the 103(a) rejection. Claims 18 and 20-24 are all ultimately dependent upon claim 16 and should therefore also be allowable.

Rejections under 35 U.S.C. §103(a)

The Examiner has rejected claims 2-3, 15, 27 and 33 under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of Yamamoto (US Patent 5,966,402). For the reasons set forth below, it is respectfully submitted that these claims are patentable over the applied art.

The limitations of claim 3 have been incorporated into claim 1. Amended claim 1 contains the element “terminating the searching and processing early upon detection of pilot acquisition.” This element is not taught or suggested in either Ogawa or Yamamoto. The Examiner states, however, that the element is taught by Yamamoto in Col. 7, lines 15-20. The Examiner is mistaken. In the section pointed to by the Examiner, Yamamoto actually teaches away from the claimed language.

Yamamoto clearly states:

The processing of the steps S5 to S8 is performed as described above on *all of the pilot candidate signals* for detection recorded on the

memory. If it is found at step S5 that all the pilot candidate signals for detection have all been searched, the present processing is terminated.

Col. 7, lines 15-20 (emphasis added).

Thus, Yamamoto teaches not the claimed early termination, but the searching of *every single* pilot candidate prior to termination of the processing. Amended claim 1 should be allowable. Claim 2 is based upon claim 1 which is believed to be allowable. Thus, claim 2 should be allowable.

Claims 15, 27, 33 and amended claims 38 and 39 contain similar language to the language added to claim 1 and should be allowable for the reasons discussed above. Additionally, the claims 27 and 33 should be allowable as being based on allowable claims, namely claim 26 and 32, respectively.

The Examiner has rejected claims 16, and 18-25 under 35 U.S.C. §103(a) as being unpatentable over Challa et al. in view of Yamamoto. This rejection is respectfully traversed.

35 U.S.C. §103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application has a filing date of October 4, 2001, prior to the issue date of the Challa reference (March 2, 2004). Thus, the Challa reference can not qualify as prior art under 35 U.S.C. §102(a) or (b). Additionally, it is obvious from the face of the reference that it is not a 35 U.S.C. §102(c) or (d) reference. Thus, it may only be a reference under one or more of subsections (e), (f) and (g).

The Challa reference and the present application were, at the time the invention covered by the present application was made, owned by, or subject to an obligation of assignment to the same person, namely Qualcomm. Both the Challa reference and the present application have been so assigned and the present application was subject to such an assignment at the time of the invention. Thus, according to 35 U.S.C. §103(c) (and MPEP 706.02(1)(2)), the Challa reference can not be used to preclude the patentability of the present application and is an improper reference and the rejection of claims 16, and 18-25 should be withdrawn.

The Examiner has rejected claims 28-29 and 34-35 under 35 U.S.C. §103(a) as being unpatentable over Ogawa in view of Van Stralen. Claims 28-29 and 34-35 are ultimately based upon claims 26 and 32, respectively, which are believed to be allowable. Thus, claims 28-29 and 34-35 should also be allowable.

In view of the foregoing, reconsideration of the application and allowance of all claims is respectfully requested. The Examiner is invited to call the undersigned agent if a telephone call could help solve any remaining issues.

Respectfully submitted,

Dated: June 21, 2004

By:


Timothy F. Loomis
Attorney for Applicant
Registration No. 37,383

QUALCOMM Incorporated
5775 Morehouse Dr.
San Diego, California 92121
Telephone: (858) 845-8355
Facsimile: (858) 658-2502

000063

13